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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,252	06/27/2001	Peter Styczynski	00216-552001 / H-245 (Kay	1872

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EXAMINER
BERMAN, ALYSIA

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 10/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/893,252	Applicant(s) AHLUWALIA ET AL.	
	Examiner Alysia Berman	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 July 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 33-48* is/are rejected.

7)☒ Claim(s) *2-32* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *9* .
4) ☐ Interview Summary (PTO-413) Paper No(s). *8,12* .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Receipt is acknowledged of the information disclosure statement and amendment filed July 1, 2002. Claims 1, 22 and 40-43 have been amended. Claims 49-51 have been canceled. Claims 1-48 are pending.

Specification

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:
(1) if a machine or apparatus, its organization and operation;
(2) if an article, its method of making;
(3) if a chemical compound, its identity and use;
(4) if a mixture, its ingredients;
(5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

The abstract of the disclosure is objected to because it is not an adequate statement of the nature and gist of the technical disclosure because it does not provide the general nature of the compounds or compositions used. Correction is required.

See MPEP § 608.01(b).

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Response to Amendment

The objections to the amendments filed October 12, 2001 and October 30, 2001 do not apply in this case and are withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 33-48 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the compounds of claims 2-32, does not reasonably provide enablement for an inhibitor of telomerase. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The specification does not provide a clear and concise definition of what is encompassed by an inhibitor of telomerase. The compounds disclosed and claimed are examples and do not represent a definition. The art is unpredictable as to what other compounds could act as telomerase inhibitors. It would take undue experimentation for one of ordinary skill in the art to test all existing compounds for telomerase inhibitory activity. Therefore, the specification is only enabled for those compounds expressly disclosed by Applicant as acting as telomerase inhibitors.

Attention is directed to *General Electric Company v. Wabash Appliance Corporation et al* 37 USPQ 466 (US 1938), at 469, speaking to functional language at the point of novelty as herein employed: "the vice of a functional claim exists not only when a claim is "wholly" functional, if that is ever true, but when the inventor is painstaking when he recites what has already been seen, and then uses conveniently functional language at the exact point of novelty". Functional language at the point of novelty, as herein employed by Applicants, is further admonished in *University of California v. Eli Lilly and Co.* 43 USPQ2d 1398 (CAFC 1997) at 1406: stating this usage does "little more than outlin[e] goals appellants hope the recited invention achieves and the problems the invention will hopefully ameliorate". Applicants functional language at the point of novelty fails to meet the requirements set forth under 35 USC 112, first paragraph. Claims employing functional language at the point of novelty, such as Applicants', neither provide those elements required to practice the inventions, nor "inform the public during the life of patent of the limits of the monopoly asserted" *General Electric Company v. Wabash Appliance Corporation et supra*, at 468.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> **The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

Claims 1 and 33-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 33-48 are rejected because the compound in these claims is not defined with any chemical or physical characteristic, but only by functional properties. A

claim to a material defined solely in terms of what it can do, or a property thereof, does not particularly point out the claimed invention. Thus, the scope is indefinite. See *ex parte Pulvari* (POBA 1966) 157 USPQ 169.

Claim Rejections - 35 USC § 102 and 35 USC § 103

In view of Applicant's remarks and upon further review of the claims and prior art, the rejections of the claims under 35 U.S.C. 102 and 103(a) are withdrawn. The prior art does not teach the step of selecting an area of skin on a mammal from which reduced hair growth is desired.

Allowable Subject Matter

Claim 1 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, first and second paragraph, set forth in this Office action.

Claims 33-48 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first and second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 2-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art does not teach or fairly suggest the use of the instantly claimed compounds of claims 2-32 for inhibiting hair growth.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.

Alysia Berman
Patent Examiner
October 17, 2002

RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200